

REMARKS**Claim Rejections Under 35 U.S.C. § 102**

Claims 1-9, 11-13, 16-18 and 20-29 were rejected under 35 U.S.C. § 102(e) as being anticipated by Smith (U.S. Patent No. 6,515,759).

Claims 1-5

Applicant has amended claim 1 to recite, in part, “wherein the imaging device contains no nonvolatile image of any control program capable of converting the image data into the printable image.” Applicant contends that this amendment is supported at least by paragraph 0030 of the Specification as originally filed. Specification, paragraph 0030 (“For one embodiment, the nonvolatile storage media 254 includes no computer-readable instructions capable of causing the processor 252 to convert image data into a printable image for use by the engine 116, i.e., the imaging device 110 contains no nonvolatile image of a formatter control program.”).

Applicant contends that this limitation is not taught or suggested by the cited reference. *See, e.g.*, Smith, column 4, lines 60-62 (“ROM 108 provides economical storage for a large amount of built-in software including fixed data items (e.g. fonts) and programs.”); column 1, lines 27-28 (“Storage of such a PDL interpreter program is conventionally provided in the printer in read only memory (ROM).”); column 1, lines 36-40 (“Support for processing large amounts of data to be printed on a single sheet may be expanded by the factory or user by adding random access memory (RAM) modules for the read/write memory functions.”). Applicant thus contends that the reference describes an imaging device using both ROM and RAM for its control programs. Applicant thus submits that the reference does not teach that the imaging device contain no nonvolatile image of any control program capable of converting image data into a printable image.

In view of the foregoing, Applicant respectfully submits that claim 1 is patentably distinct from the cited reference. As claims 2-5 depend from claim 1 and include all patentable limitations of claim 1, these claims are also believed to be allowable. Applicant thus respectfully requests reconsideration and withdrawal of the rejection under 35 U.S.C. § 102(e), and allowance of claims 1-5.

Claims 6-9

Claim 6 recites, in part, “providing a signal on the communication output of the imaging device indicative of a desire to transfer a control program from an external device to the communication input of the imaging device” and “waiting for a control program to be received on the communication input of the imaging device in response to the signal.”

Applicant contends that the imaging device of Smith does not purport to initiate a request for a control program from an external source. In particular, Applicant contends that the cited reference does not teach that a signal is provided on a communication output of the imaging device indicative of a desire to transfer a control program from an external device to a communication input of the imaging device, nor that it waits for a control program to be received on the communication input in response to the signal.

The Office Action asserts that the Smith reference discloses that the control program can be requested from an external device in its Abstract. Office Action, page 4, first paragraph. Applicant contends this is a mischaracterization of the reference. While Smith’s Abstract does disclose that the control program can be received from an external computer, it does not disclose requesting that control program. Applicant acknowledges that it is common to allow an imaging device to accept control programs from external devices. However, Applicant contends that common practice is to initiate the choice of control program at the external device, not at the imaging device as claimed by Applicant.

To support the rejection, the Office Action must be taking official notice of facts outside the record indicating that receiving the control program is necessarily the result of a request for the control program from the imaging device. However, because common practice is to initiate choice of control programs at the external device, Applicant contends that a rejection based on inherency cannot be supported. *See*, MPEP § 2112 (“In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original)).

In view of the foregoing, Applicant respectfully submits that claim 6 is patentably distinct from the cited reference. As claims 7-9 depend from claim 6 and include all patentable limitations of claim 6, these claims are also believed to be allowable. Applicant thus respectfully requests reconsideration and withdrawal of the rejection under 35 U.S.C. § 102(e), and allowance of claims 6-9.

Claims 11-13, 16-18 and 20

Claim 11 recites, in part, “generating a request for a control program upon an initialization of the imaging device, wherein the control program is adapted to convert image data received by the imaging device into a printable image,” “providing the request on a communication output of the imaging device” and “waiting to receive the control program via a communication input of the imaging device.” As noted with respect to claim 6, Applicant contends that the imaging device of Smith does not purport to initiate a request for a control program from an external source.

In view of the foregoing, Applicant respectfully submits that claim 11 is patentably distinct from the cited reference. As claims 12-13, 16-18 and 20 depend from claim 11 and include all patentable limitations of claim 11, these claims are also believed to be allowable. Applicant thus respectfully requests reconsideration and withdrawal of the rejection under 35 U.S.C. § 102(e), and allowance of claims 11-13, 16-18 and 20.

Claims 21-29

Claim 21 recites, in part, “generating a request, in response to an initialization process, for a control program for converting image data into a printable image,” “providing the request on a communication output of the processor” and “waiting to receive the control program via a communication input of the processor.” As noted with respect to claim 6, Applicant contends that the imaging device of Smith does not purport to initiate a request for a control program from an external source.

In view of the foregoing, Applicant respectfully submits that claim 21 is patentably distinct from the cited reference. As claims 22-29 depend from claim 21 and include all patentable limitations of claim 21, these claims are also believed to be allowable. Applicant thus respectfully requests reconsideration and withdrawal of the rejection under 35 U.S.C. § 102(e), and allowance of claims 21-29.

Allowable Subject Matter

Claims 10, 19, 30 and 31 were objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form, including all of the limitations of the base claim and any intervening claims. Applicant submits that it has shown the respective base claims and intervening claims to be allowable over the cited reference.

As such, Applicant contends these claims are allowable in their current form. Applicant thus respectfully requests reconsideration and withdrawal of the objection, and allowance of claims 10, 19, 30 and 31.

CONCLUSION

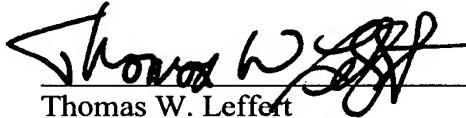
Claim 1 is amended herein. Claims 1-31 are now pending.

Applicant believes that the claims are in condition for allowance and respectfully requests a Notice of Allowance be issued in this case. If the Examiner has any questions regarding this application, please contact the under-signed at (612) 312-2204. No new matter has been added and no additional fee is required by this amendment and response.

Respectfully submitted,

Date:

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